

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

First Named

Inventor : David S. Majkrzak

Appln. No.: 10/772,122

Filed : February 4, 2004

For : HIGH CAPACITY SICKLE SECTION

Docket No.: C136.12-0016

Group Art Unit: 3671

Examiner: Torres, Alicia M.

REPLY BRIEF FOR APPELLANT

FILED ELECTRONICALLY

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

December 12, 2008

Sir:

This is responsive an Examiner's Answer mailed on October 16, 2008.

STATUS OF THE CLAIMS

- I. Total number of claims in the application.
- Claims in the application are: 1-16
- II. Status of all the claims.
- A. Claims cancelled: 3 and 6-15
- B. Claims withdrawn but not cancelled: None
- C. Claims pending: 1, 2, 4, 5 and 16
- D. Claims allowed: None
- E. Claims rejected: 1, 2, 4, 5 and 16
- F. Claims Objected to: None
- III. Claims on appeal
- The claims on appeal are: 1, 2, 4, 5 and 16

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- I. Whether claim 16 is made obvious under 35 U.S.C. § 103(a) by the combination of the Poget patent in view of Isbell U.S. Patent No. 4,380,889 (hereinafter the Isbell patent).
- II. Whether claims 1, 2, 4 and 5 were properly rejected under 35 U.S.C. § 112, first paragraph, as including new matter.

ARGUMENT

I. The Office Action Erred in Rejecting Claim 16 as being Obvious over the Combination of the Poget Patent in view of the Isbell Patent.

The Examiner's reply brief erroneously states that there is no novelty seen either by the examiner or pointed out by the appellant, nor is it clear that the invention would solve any stated problem or serve any purpose that the sickle of Poget and Isbell could not. Appellant respectfully disagrees with these assertions.

First the claimed structure of the sickle provides for a high cutting capacity as stated in the title of the application. As stated at page 1, lines 7-9, the sickle allows for cutting of small stalks and the cutting of as many stalks as possible in one stroke. The high capacity of the sickle is also disclosed at page 5, lines 5-16. The high capacity of the sickle is due to its substantially arcuate cutting edge as claimed which forms the claimed substantially elliptical cutting edge when two sickle sections are placed side by side. The high capacity is due to the area defined by the cutting edge between the adjacent sickles. Therefore, the claimed curved cutting edge is necessary to increase the capacity of the sickle.

Further, the Declaration of Mr. Dave Majkrzak, which was submitted on August 24, 2006, further defines the inventive and novel features of the claimed sickle. The design of the sickle section as claimed provides unique harvesting features including a high capacity, high efficiency sickle section that is utilized to cut soybeans and small grain including wheat and oats. (Declaration of David Majkrzak (Majkrzak Decl.), ¶¶ 3, 4. The concave cutting edges increase the cutting capacity of the cutting bar relative to the cutting bar having sickle sections with straight cutting edges because the area between the cutting edges is increased. This increase capacity allows the cutting or the harvester to move more quickly through a field to reduce the time required to harvest a crop. (Majkrzak Decl., ¶¶ 12, 16, Exhibit C). Providing a high efficiency, high capacity sickle section meets a long felt need of the reduction of time to harvest crops.

Further, the claimed sickle sections have been surprisingly found to work very efficiently in no till or minimum till crops where a crop is planted into the prior crop's residue. (Majkrzak Decl., ¶¶ 6-8). When a crop is planted into cornstalks, there are difficulties in harvesting small grain and soybeans due to the condition of the upright stalks (Majkrzak Decl.,

¶¶ 9-11). Many sickle sections utilized on a cutting bar are not able to cut through these dried hardened stalks having the consistency of wood and the sections tend to become damaged or broken which causes down time of the harvester for repair. The claimed sickle section has surprisingly been found capable of cutting cornstalks including genetically altered stalks of corn which are even more hard than a normal corn stalk due to their ability to resist cornborers. ((Majkrzak Decl., ¶ 15, Exhibit B). Therefore, the design of the present invention has surprisingly been found to be beneficial in harvesting crops in no tillage and minimum tillage fields.

Further the present application contrasts the claimed invention with a straight edged sickle at page 5, lines 5-17 and Fig. 3. A straight edged sickle does not have the capacity of the claimed sickle because of the lack of area defined by the cutting edges. The cutting edges of a straight edged sickle form a “V” shaped cutting edge. The Poget patent discloses a very slightly curved cutting edge which approximates a “V” shaped cutting edge of a straight edged sickle. Therefore, the Poget patent does not disclose a high capacity sickle as claimed.

The reason that a substantially elliptical cutting edge is claimed is to increase the cutting area between two adjacent sickle sections, which in turn increases the capacity of the claimed sickle. The Poget patent discloses a substantially straight cutting edge when compared to the arcuate shape of the cutting edge of the disclosed sickle. The Poget patent simply does not disclose a structure which could be utilized as a high capacity sickle section due to the lack of area between the adjacent cutting edges.

Therefore, Appellant submits that the Office Action erred in rejecting claim 16 as being obvious over the combination of the Poget patent and the Isbell patent. Reversal of the obviousness rejection of claim 16 is respectfully requested.

II. The Office Action Erroneously Rejected Claim 1, 2, 4 and 5 as Containing New Matter.

The Examiner’s Answer did not dispute any of the facts and arguments provided by Appellant in the Appeal Brief. Rather the Examiner’s Answer stated that Appellant cannot rely on the drawings as being to scale without the extra step of declaring that the drawings were to scale. See page 6, last sentence of the Examiner’s Answer.

Appellant reiterates its position that the Examiner is confusing what is new matter in a patent application and what the scope of prior art drawings. The Examiner relied upon the

Hockerson-Halberstadt, Inc. v. Avia Group Int'l. 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) to maintain the rejection under 35 U.S.C. § 112, first paragraph.

Regarding *Hockerson*, the case stands for the proposition of what is prior art and what is disclaimed matter. The *Hockerson* case did not mention whether or not an amendment made to a claim was new matter or not. Rather, *Hockerson* related to the scope of a drawing in the prior art and the statements made to overcome the rejection based upon the prior art. It is telling that this case is cited in the MPEP § 2125 entitled in part Drawings as **Prior Art**. (Emphasis added). The Examiner is simply misapplying a holding regarding prior art drawings to a new matter analysis.

In a new matter analysis, an applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, **figures**, diagrams and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). (Emphasis added). It is undisputed that Appellant submitted the drawings with the claimed ratio at issue when the application was filed. It is undisputed that Appellant had possession of the claimed subject matter as of the filing date. Therefore, no new matter has been added to claim 1 with the inclusion of the claimed ratio.

While stating that a drawing is to scale for purposes of the scope of the prior art may be required, it is not necessary to state the drawings are to scale for purposes of a new matter rejection because it is clear the drawings, along with its dimensions, were disclosed at the time of filing. Therefore, the Examiner erred in rejecting claims 1-5 and Appellant respectfully requests that the new matter rejection of claims 1-5 be reversed.

CONCLUSION

Appellants respectfully submit that claims 1-5 and 16 are in allowable form.
Appellants therefore request reversal of the rejections of claims 1-5 and 16.

Respectfully submitted,

WESTMAN, CHAMPLIN & KELLY, P.A.

By: /Peter J. Ims/
Peter J. Ims, Reg. No. 48,774
900 Second Avenue South – Suite 1400
Minneapolis, Minnesota 55402-3244
Phone:(612) 334-3222 Fax:(612) 334-3312

PJI:mek